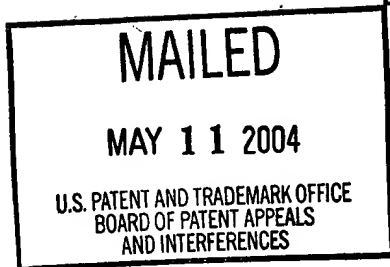


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JOHN SKALEN

Appeal No. 2004-0064
Application No. 09/787,750

ON BRIEF

Before COHEN, ABRAMS and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision in response to appellant's request for rehearing¹ of our decision mailed December 23, 2003 (Paper No. 19) sustaining the examiner's rejection of claims 6, 7 and 11 as being unpatentable over Deane in view of Windall and claims 8-10 as being unpatentable over Deane in view of Windall and official notice. For the reasons which follow, this panel's reconsideration of appellant's argument in light of the

¹ Appellant's "REQUEST FOR RECONSIDERATION AND/OR REMAND UNDER 37 C.F.R. § 1.197(b) AND/OR 37 C.F.R. § 1.196" is treated as a request for rehearing under 37 CFR § 1.197(b).

claims on appeal and appellant's specification has led us to the inescapable conclusion that claim 6, and claims 7-11 depending therefrom, are indefinite. We thus hereby withdraw our earlier decision in favor of the decision below, in which we reverse the prior art rejections of the examiner and enter a new rejection of the claims under 35 U.S.C. § 112, second paragraph, as being indefinite.

BACKGROUND

The appellant's invention relates to a golf swing training apparatus. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Windall	3,122,369	Feb. 25, 1964
Deane (British patent specification)	401,955	Nov. 23, 1933

The following rejections are before us for review.

Claims 6, 7 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deane in view of Windall.

Claims 8-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deane in view of Windall and official notice.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer

(Paper No. 15) for the examiner's complete reasoning in support of the rejections and to the brief, reply brief and request for rehearing (Paper Nos. 14, 16 and 22) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner.² As a consequence of our review, we make the determinations which follow.

We shall not sustain the examiner's 35 U.S.C. § 103 rejections of claims 6-11. For the reasons expressed below in the new ground of rejection, these claims are indefinite. Therefore, the prior art rejections must fall because they are necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

² In light of our disposition of the rejections and claims in this appeal, infra, consideration and discussion of the declaration under 37 CFR § 1.132 accompanying the request for rehearing is not required in this decision.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection of claims 6-11.

Claims 6-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

Claim 6, the sole independent claim pending in this application, reads as follows:

6. A golf swing training device, comprising:
 - a golf ball;
 - a rigid line wherein a first end of said rigid line is secured to said golf ball and a second end of said rigid line is anchored to the ground at a predetermined distance in front of said golf ball;
 - a resilient line that is transverse to said rigid line and approximately bisected by said rigid line, said resilient line has both a first end and a second end anchored to the ground;
 - a ring that encloses said rigid line and said resilient line, wherein said ring is slidable along said rigid line and said ring is slidable along said resilient line; and

a plurality of marks located on said rigid line wherein a mark indicates a reference point for said resilient line to transverse said rigid line^{3]} and said mark indicates a type of a golf club for a player to use when said resilient line crosses said rigid line at said mark.

The relationship, if any, between the “plurality of marks” recited in the last paragraph of claim 6 and the positions of the rigid and resilient lines anchored to the ground as recited in the second and third paragraphs is not clear. We note that the rigid line and resilient line are positively recited as being anchored (not adapted to be anchored, for example) to the ground, the rigid line at one end and the resilient line at both ends, with the resilient line being transverse to the rigid line and approximately bisected by the rigid line. Claim 6, in the last paragraph, recites a plurality of marks, wherein a mark indicates a reference point for the resilient line to transverse the rigid line and wherein said mark indicates a type of a golf club for a player to use when said resilient line crosses said rigid line at said mark. Inasmuch as claim 6 does not positively recite that the crossing of the resilient line and the rigid line at said mark referred to in the last paragraph corresponds to the position of anchoring of the lines recited in the second and third paragraphs of the body of the claim, it is not clear whether claim 6 is directed to (1) a golf swing training device with the rigid and resilient

³ The examiner's statement on page 2 of the answer that the copy of the claims contained in the Appendix to the brief is correct notwithstanding, our review of the file history reveals that the language “when the first and second ends of said resilient line are anchored to the ground for correct operation of the device with a particular” is not in fact part of claim 6.

lines anchored such that the resilient line crosses the rigid line at a mark (i.e., a golf swing training device arranged in a particular manner for use with a predetermined type of club) or to (2) a golf swing training device comprising the rigid and resilient lines anchored with the resilient line crossing the rigid line at any point, either at a mark or not at a mark, and being approximately bisected by the rigid line, with the rigid and resilient lines being capable of being re-positioned and re-anchored such that the resilient line crosses the rigid line at a mark (i.e., a golf swing training device adapted for arrangement for use with a type of club of the user's choosing).

In an attempt to resolve the above-mentioned ambiguity, we have consulted appellant's specification. For the reasons which follow, appellant's specification not only fails to clarify this point but, in fact, heightens the ambiguity.

The present specification informs us, on page 1, that the present invention relates to a golf training arrangement comprising a rigid line having a free end "adapted to be anchored in the ground at a predetermined distance in front of the ball" and an elastic line having free ends which are "adapted to be anchored in the ground." This disclosure might lead us to the conclusion that interpretation (2) above is the correct reading of claim 6.

The specification also discloses on page 2 that "identified sections along the front portion of the rigid line indicate the distance from the ball to the ring interconnecting the lines and to the crossing elastic line, thereby providing an

indication about which type of club [is] to be used." This language is ambiguous as to whether interpretation (1) or (2) is correct, inasmuch as it implies a particular arrangement of the device, as called for in interpretation (1), but with the markings ("identified sections") simply indicating distance to the crossing rather than marking the actual point of crossing. In other words, the referenced disclosure on page 2 of the specification does not indicate that the lines must cross at a mark.

Finally, page 5 of appellant's specification states that

[t]he distance from the ball to the crossing line 7 is marked on the rigid line 3 with sections A-C which could have the colours blue A, white B and yellow C. With reference thereto the location of the golf ball relatively the metal ring 6 and the crossing line 7 can easily be determined in response to the type of club used at the training.

This disclosure implies that the intent of the invention is to provide a training device wherein the crossing point of the rigid and elastic or resilient lines is determined in response to the type of club used in training, thus pointing toward interpretation (2). Moreover, this disclosure describes the marks or colored sections A-C as marking distance from the ball to the crossing line rather than the location of the crossing itself and thus, like that on page 2 of appellant's specification, referred to above, appears to be inconsistent with the recitation in claim 6 that "said mark indicates a type of a golf

club for a player to use when said resilient line crosses said rigid line at said mark," thereby rendering claim 6 indefinite.⁴

In light of the ambiguity and inconsistency discussed above, the metes and bounds of claim 6 cannot adequately be determined, thereby rendering the claim indefinite. Claims 7-11 depend from claim 6 and are likewise indefinite.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6-11 under 35 U.S.C. § 103 is reversed and a new ground of rejection of claims 6-11 under 35 U.S.C. § 112, second paragraph, is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b), which provides that "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so

⁴ Even claim language which may appear, for the most part, to be understandable when read in abstract, may be indefinite when such language is inexplicably inconsistent with the underlying disclosure, as no claim may be read apart from and independent of the supporting disclosure on which it is based. See In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)



IRWIN CHARLES COHEN
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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